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APR 11 2005

OFFICE OF PETITIONS

In re Application of :  
Andrew R. Searle, et al. :  
Application No. 09/582,796 :  
Filed: August 23, 2000 :  
Attorney Docket No. 938 26 005 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), or in the alternative, 37 CFR 1.137(b), filed December 8, 2004, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;<sup>1</sup> (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks items (1) and (3).

A final Office action was mailed to applicant on June 7, 2004, which set a three (3) month shortened statutory period for reply. Since no reply was received and no extensions of time under the provisions of 37 CFR 1.136 were obtained, the application became abandoned on September 8, 2004.

With regard to item (1):

The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in

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<sup>1</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

condition for allowance, a request for continued examination (RCE) under 37 CFR 1.114, or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2). **Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), a request for continued examination under 37 CFR 1.114, or the filing of a continuing application.** A copy of the Examiner's Advisory Action is attached herewith.

With regard to item (3):

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay. Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner alleges that an amendment was timely filed via facsimile transmission on August 5, 2004. Petitioner also alleges the fax was successfully transmitted and has provided a copy of a "Call Detail Page 2" (hereinafter "Call Detail") to support that the fax was transmitted to the Office. Additionally, petitioner submits a copy of the 9-page amendment with the instant petition.

While the amendment contains a certificate of facsimile transmission under 37 CFR 1.8 dated August 5, 2004 and the Call Detail shows a fax was sent to the USPTO on August 5, 2004, the Call Detail also shows that the fax was transmitted in 18 seconds. It is reasonable to conclude that a 9-page document cannot be transmitted in 18 seconds, which further shows the amendment was not successfully transmitted, as petitioner suggests. 37 CFR 1.8(b) in pertinent part states:

"In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence...includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. **If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement. ...The Office may require additional evidence to determine if the correspondence was timely filed.**" (Emphasis added)

Although petitioner has provided the Call Detail, it does not verify successful facsimile transmission of the amendment. A transmission confirmation report would be more suitable in this instance.

In view of the above, petitioner has not established that the delay in submitting a reply to the outstanding office action was unavoidable.

Moreover, a grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition

pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). The petition lacks item (1) as already stated. Again, the application will not be revived until a proper reply is received.

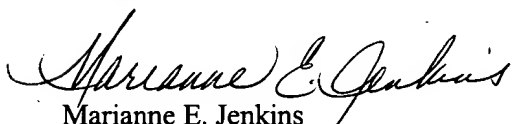
Since the petitions under 37 CFR 1.137(a) and 1.137(b) have both been considered by the Office, the petition fees of \$500 and \$1500, respectively, will be charged to petitioner's deposit account, as authorized.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:                      Mail Stop PETITION  
                                    Commissioner for Patents  
                                    P. O. Box 1450  
                                    Alexandria, VA 22313-1450

By hand:                     U. S. Patent and Trademark Office  
                                    Customer Service Window, Mail Stop Petitions  
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                                    401 Dulany Street  
                                    Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.



Marianne E. Jenkins  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

Attachment:    Examiner's Advisory Action